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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,555	02/27/2004	Peter G. Knopp	9065.ALG.P	7054

69814 7590 04/06/2009  
BROOKS, CAMERON & HUEBSCH, PLLC  
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MINNEAPOLIS, MN 55403

EXAMINER
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EIDE, HEIDI MARIE

ART UNIT	PAPER NUMBER
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3732

MAIL DATE	DELIVERY MODE
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04/06/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/788,555	<b>Applicant(s)</b> KNOPP, PETER G.	
	<b>Examiner</b> HEIDI M. EIDE	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-12, 14, 16-21 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2, 4-6, 8-12, 14 and 25-27 is/are allowed.
- 6) ☒ Claim(s) 3 and 16-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 17, 2009 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "the first duration" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "the second duration" in 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al. 5,957,893 (Chishti). Chishti teaches a system comprising means for moving a first tooth with a dental appliance having a number of cavities in which one or more teeth are positioned and wherein the at least one tooth is positioned in one of the cavities and a means capable of isolating the first tooth at a rest position by relieving the force applied to it, while moving at least one second tooth, wherein relieving the force applied to the first tooth is capable of being accomplished by creating space around the tooth and within the one of the cavities such that no force applying contact is made by the appliance or the second tooth (col. 8, ll. 50-63). The system taught by Chishti is obviously capable of functioning as claimed, since it is well known in the art that teeth of different sizes exist, making the system taught by Chishti capable of functioning as claimed depending on the size of the teeth the system is applied to. Chishti further teaches the system capable of moving the second tooth for a first duration and immobilizing the second tooth for a second duration and the second duration can be any of an hourly, daily or weekly basis. Chishti further teaches the system comprising a fabrication machine (col. 6, ll. 58-62) to generate a plurality of appliances, wherein the appliances comprise polymeric shells having cavities and wherein the cavities of successive shells have different geometries shaped to receive and resiliently reposition the teeth from one arrangement to a successive arrangement and wherein the first cavity is capable of isolating the first tooth at the rest position and wherein a second cavity urges the at least one second tooth to a successive arrangement (col. 4, ll. 7-19,

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col. 8, ll. 50-67). Chishti further teaches a system for generating one or more appliances for a patient having a number of cavities in which one or more teeth are positioned and wherein the at least one first tooth is positioned in one of the cavities, the system comprising a processor, a display device coupled to the processor (col. 5, ll. 49-51), a data storage device coupled to the process (col. 5, ll. 65-67), a canner coupled to the processor for providing data to model the patient's masticator system (col. 5, ll. 43-45), a means for modeling and isolating the first tooth at a rest position while moving at least one second tooth and a dental appliance fabrication machine coupled to the processor for generating the appliances in accordance with the modeling of isolating the first tooth and moving at least one of the at least one second tooth (col. 6, ll. 56-52, col. 12, ll. 35-44). . Chishti further teaches the system is capable of creating space between the appliance and the teeth (col. 12, ll. 35-44), therefore the system is capable of creating an appliance such that no force applying contact is mate by the appliance or the at least second tooth on the first tooth. While Chishti does not specifically teach the system functioning as claimed, the device is capable of functioning as claimed as discussed above. The system taught by Chishti is obviously capable of functioning as claimed, since it is well known in the art that teeth of different sizes exist, making the system taught by Chishti capable of functioning as claimed depending on the size of the teeth the system is applied to

### ***Response to Arguments***

In response to applicant's argument that the appliance does not apply a force to the tooth, a recitation of the intended use of the claimed invention must result in a

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structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

***Allowable Subject Matter***

Claims 1-2 and 4-6, 8-12, 14 and 25-27 are allowed.

Claim 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEIDI M. EIDE whose telephone number is (571)270-3081. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**Heidi Eide**  
**Examiner**  
**Art Unit 3732**

**/John J Wilson/**  
**Primary Examiner**  
**Art Unit 3732**

/Heidi M Eide/  
Examiner, Art Unit 3732

4/2/2009